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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,307	07/20/2000	John William Carrol	FREA,002	3416

7590

07/14/2003

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 07/14/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**  
*File Copy*

**Application No.**

09/621,307

**Applicant(s)**

CARROL, JOHN WILLIAM

**Examiner**

JYOTHSNA A VENKAT

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-39 and 41-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of extension of time, amendment A, change of address and declaration filed on 4/16/03. Claim 6 has been canceled as per applicant's amendment dated 4/16/03. Claims 1-5, and 7-42 are pending in the application and the status of the application is as follows:

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-39 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patents 5,431, 924 ('924) and 5,795,573 ('573) and 6,444,238('238) and Skin Care and Cosmetic Ingredient Dictionary page 40, 1994.

*The instant application is claiming Therapeutic composition and method of treating arthritis or pain comprising:*

1. *EMU oil*
2. *Arnica Montana*
3. *Rosemary oil*
4. *Eucalyptus oil*
5. *Camphor*
6. *Ethanol*
7. *Fragrance*

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The patent '924 teaches EMU oil as an anti-inflammatory along with eucalyptus oil. See the abstract, see col.2, lines 38-40, see col.4, lines 50-58 and see example 1 where the patent also teaches perfumes or fragrance. The patent '573 teaches Arnica Montana in pain relieving compositions and anti-inflammatory compositions. See the abstract, see col.2 and see the examples where the formulation is in the form of gel, crème and lotion. The patent '238 teaches ingredients 3-5 in pain relieving compositions. See the abstract, see col.2, lines 1-55 and see the examples. Thus all these patents teach some of the ingredients together for treating pain. The dictionary is cited to show that the alcohol is used in the cosmetics as solvents.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '924 and it with *Artica Montana* of '573, and *Rosemary oil, eucalyptus oil, and camphor* of '238 and add *ethanol* which is used conventionally as a solvent expecting beneficial effect to the skin which is treating inflammation. The idea of combining the ingredients flows logically from the art for having been used for the same purpose. This is a prima facie case of obviousness.

### ***Response to Arguments***

3. Applicant's arguments filed 4/16/03 have been fully considered but they are not persuasive.

Applicants argue that the '573 reference teaches the combination of *Arnica Montana, rhus toxicodendron, aescus hippocastanum* and *belladonna* and one of ordinary skill in the art, when reading the '573 reference would not be directed to the inventive combination defined by claim 1 and the '924 reference teaches the use of *emu oil* in topical compositions and the reference teaches the extracted emu oil as the active ingredient and no extraction steps of emu oil

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are necessary in the present invention and the '238 reference teaches the combination of aloe vera, eucalyptus oil, lemon oil, orange oil, peppermint oil and **Rosemary oil** and **Rosemary oil** is taught as only one essential constituent of a total of six essential constituents and one of ordinary skill in the art would not be directed to the combination as defined in claim 1 and hence one of ordinary skill in the art, from reading the cited art, would not arrive at therapeutic composition that achieves greater inflammation reduction by combining Arnica, Rosemary oil and emu oil defined by claim 1.

4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the '924 reference teaches the use of **emu oil** for treating inflammation and the '523 reference teaches **Arnica Montana** for relieving inflammation and the '238 reference teaches **Rosemary oil** for relieving pain. Thus the combination of the ingredients defined by claim 1 is taught individually for the same purpose. The idea of combining the ingredients flows

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logically from the art for having been used individually for the same purpose. Therefore the claims are obvious within the meaning of 103 over the combination of the references.

***Allowable Subject Matter***

6. Claim 40 is allowed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30: 1st and 2nd Friday off.

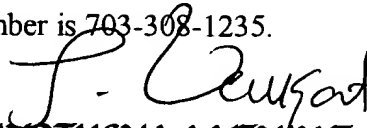
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
**JYOTHSNA A VENKAT**  
Primary Examiner  
Art Unit 1615

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July 10, 2003